

REMARKS

The Examiner provides a number of objections and rejections. We list them here in the order in which they are addressed.

I. Claims 1, 7-13, 17, 18, 20-23 and 25-29 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Theodorakis *et al.* (1997).

II. Claims 2-6, 14-16, 19 and 24 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Theodorakis *et al.* in view of Remsen *et al.* (US 2003/0167283).

Applicants respond as follows:

I. **Claims 1, 7-13, 17, 18, 20-23 and 25-29 are not anticipated by Theodorakis *et al.* (1997).**

The Examiner has rejected Claims 1, 7-13, 17-18, 20-23 and 25-29 under 35 U.S.C. §102(b) as allegedly being anticipated by Theodorakis *et al.* The Applicants disagree.

As a preliminary point, the Applicants emphasize that Theodorakis *et al.* focuses on developing a context mechanism for an information base and exploiting this mechanism for naming purposes (see the Abstract specifically and the entire text generally). Theodorakis *et al.* is unlike the presently claimed invention since it creates new names rather than resolving ambiguities between existing names. By contrast, the present invention resolves ambiguity in names that already exist and are controlled by third-party conventions. Specifically, the present invention separates names from named objects in order to elucidate relations between them and resolve synonymous, homonymous and polysemous names that are governed by third-party convention. While this critical distinction is enough to defeat the Examiner's anticipation rejection, the Applicants also specifically disagree with the individual elements that the Examiner alleges as being taught by Theodorakis *et al.* – some of which are listed below.

1. Within networked systems, the method provides software which identifies objects with ambiguous identifications (section 3.1, p. 272)... Office Action, p. 2 last sentence.

First, this passage (indeed the entire reference) says nothing about “networked systems” or “software” that identifies objects with ambiguous identifications as alleged by the Examiner. More importantly, however, this passage provides an example of a naming scheme that creates – rather than resolves – ambiguities. *See Theodorakis et al. p.273, section 3.1.*

Therefore, naming schemes like the one above are not “natural” enough and problems can arise. In particular, names turned out to be:

- **Ambiguous**, in the sense that names can be homonyms (for example, Sec. 2 of *CBN* and Sec. 2 of *CBN_old*), or synonyms.
- **Excessively** long in order to resolve ambiguities. This results in composite names with redundant name substrings...
- **Inconsistent**, that is, unrelated to or unable to follow the changes of the environment of the named object.

2. This unique identifier is accessible through normal networked processors and computers. Office Action p. 3, first full sentence.

The Applicants disagree. The Examiner fails to cite exactly where in Theodorakis *et al.* this alleged teaching exists. Having reviewed this reference in full the Applicants were unable to locate the terms “processor” or “computer”, while the term “network” only appears twice in an unrelated context. This reference clearly fails to disclose networked processors and/or computers and therefore cannot be used to support a rejection under 35 U.S.C. §102(b)

3. The identifier is addressed by content and path identifiers, through object identifiers, such as DOI. Office Action, p. 3, second full sentence.

The Applicants disagree. The Examiner again fails to indicate where in Theodorakis *et al.* this alleged teaching exists. Again, having reviewed this reference in full the Applicants are unable to locate the terms “digital” or “identifier” separately, let

alone as part of the term digital object identifier (DOI) as currently alleged. As indicated above, this reference again fails to disclose each and every element of the present invention and therefore cannot be used to support a rejection under 35 U.S.C. §102(b).

4. Once the persistent identifier is created, it is linked in an “active region” such as a hyperlink to other names, context information, data or pathways. *Office Action*, p. 3 lines 5-6.

The Applicants again disagree. The Examiner fails to indicate where the term “active region” appears in this reference. The Applicants were again unable to locate either word independently, let alone as part of the phrase “active region”. This reference also fails to mention the term “hyperlink” (“hypertext” and “hypermedia” were the closest words identified) as presently alleged. Again, since this reference does not teach the elements alleged it cannot be used to support a novelty rejection.

II. Claims 2-6, 14-16, 19 and 24 are not obvious over Theodorakis *et al.* in view of Remsen *et al.* (US 2003/0167283).

The Examiner rejects Claims 2-6, 14-16, 19 and 24 as allegedly being obvious in view of Theodorakis *et al.* in view of Remsen *et al.* The Applicants disagree.

While the Applicants disagree with the Examiner’s assessment of Remsen *et al.* such arguments are moot in view of the above-indicated deficiencies of Theodorakis *et al.* as a primary reference. As such, a rejection of these under 35 U.S.C. §103(a) also cannot stand.

However, the Applicants must emphasize that even if these references were individually valid (which they are not) the Examiner’s basis for their combination is impermissible. The motivation by which a skilled artisan would find it obvious to combine references cannot be based (solely!) on the “complex” nature of the problem being solved – regardless of whether or not that problem is “well known in the art” (*Office Action*, p. 4, *Ins* 23-24). This logic would make obviousness rejections easier as the problem being solved gets more complicated. A solution to a problem recognized by a given field as being “complex” should face a higher burden for rejections based on obviousness – not a lower one. Reference(s) that highlight a complex problem without

even hinting at the solution are more correctly identified as establishing a “long felt need” or “failure of others.” See MPEP 716.04. Rather than “providing motivation to combine,” such factors are objective indicators of unobviousness. Therefore, the combination of references supporting this rejection (assuming they were proper) is clearly based on impermissible hindsight driven analysis.

Finally, the Applicants question where exactly in Remsen the Examiner finds support for the assumption that “the same computer and database programming skills are required”? This is simply the Examiner’s opinion and cannot be used to justify a “reasonable expectation of success”.

For at least the reasons provided above the Applicants contend that this rejection should also be withdrawn.

CONCLUSION

Based on the arguments provided above, Applicants believe that claims 1-13 and 17-29 are in condition for allowance. Should the Examiner believe a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned.

Respectfully submitted,

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